

**REMARKS**

The Office Action dated May 5, 2004 has been reviewed and carefully considered. Claims 1-17 remain pending in this case, claims 1, 3, 7, 12 and 15 being the independent claims. The Examiner's allowance of claims 7-17 is appreciated. Reconsideration of the above-identified application in view of the following remarks is respectfully requested.

Claims 1 and 2 stand rejected under 35 U.S.C. 103(a) as unpatentable over U.S. Patent No. 6,148,197 to Bridges et al. ("Bridges") in view of U.S. Patent No. 6,456,839 to Chow et al. ("Chow").

Claim 1 recites:

A home-zone location registering method for a portable radio telephone to provide a first charging rate for a telephone call made inside a predetermined home zone and a second charging rate for a telephone call made outside the home zone, the method comprising the steps of: . . . responsive to the determination of deviation, informing, by the portable radio telephone, to a mobile switching center of said determination of deviation.

Item 3 of the Office acknowledges that the Bridges reference fails to disclose or suggest the first and second charging rates.

Bridges likewise fails to disclose or suggest, "responsive to the determination of deviation, informing, by the portable radio telephone, to a mobile

switching center of said determination of deviation.” The Office Action is silent on this point.

FIG. 3 in Bridges shows a determination of deviation (S.6: NO branch), but that determination results merely in an internal search by the mobile phone (S.10) and in the making of a subsequent internally-made decision (S.12) as to whether the current carrier is preferred. Depending on the outcome of the decision, the mobile terminal either remains with its current carrier or obtains service from a band it identifies from another internal search. No informing occurs to a message switching center (MSC) of the determination of deviation responsive to that determination.

Modifying Bridges in view of Chow cannot cure this deficiency. Again, the Office Action is silent on how it envisions modifying Bridges in view of Chow.

Chow adjusts billing charges or disconnects a call when a subscriber leaves both the home zone and any subscribed-to visitor zones, but fails to disclose or suggest a mobile terminal making the determination as to whether it is in its home zone. Perhaps, the Office Action envisions that an additional box be placed in Bridges FIG. 3 between S.6 and S.10 specifying that the mobile terminal informs the MSC of the determination of deviation so that the MSC can appropriately bill the subscriber. Such a suggestion would be ill-founded, at least because the intelligent roaming process of Bridges FIG. 3 is performed only upon initialization of the mobile terminal (S.2). Such

initialization occurs, for example, when the subscriber selects Intelligent Roaming mode, but it would be unreliable to expect the subscriber to make the selection if it means the subscriber would be billed at a higher rate. The only reason the subscriber is using Intelligent Roaming is to save money (col. 4, line 35: "best roaming agreement"). The whole idea of waiting for the user to make a selection so that higher billing rates can be charged to the user is probably unworkable and awkward at best. Moreover, the Chow network detects when a subscriber on an active call leaves a home zone/visitor zone so as to either drop the call or charge more. Shifting this billing control function to the mobile phone leaves open the possibility that user equipment might be fraudulently manipulated to avoid detecting deviation from the home zone, to lower billing charges. It therefore would not have been obvious to make this shift. The present invention, by contrast, is motivated by the lowering of overhead on the network of unnecessary pages to a phone that has deviated from its home zone (specification, page 4, lines 11-17).

For at least all of the foregoing reasons, the invention as recited in claim 1 would not have been obvious over Bridges in view of Chow. Reconsideration and withdrawal of the rejection is respectfully requested.

Claims 3-6 stand rejected under 35 U.S.C. 103(a) as unpatentable over Bridges in view of Chow and U.S. Patent No. 5,642,398 to Tiedermann, Jr. et al. ("Tiedermann").

Claim 3 recites a method for a mobile switching center that includes the steps of:

“upon receiving a call origination from the portable radio telephone, releasing the call origination if the portable radio telephone is deviated from the home zone;

disregarding a call termination if the portable radio telephone deviated from the home zone receives the call termination;”

Item 4 of the Office Action cites lines 24-25 of column 7 in Chow for disclosure of the above-quoted call-termination disregarding step.

The cited passage relates to mobile subscriber who travels outside a home zone (HNZ), and, in addition, outside any and all subscribed-to visitor zones (VNZ). One of the billing options, in such an event, is to disconnect any ongoing call the subscriber is on (col. 7, lines 21-24). Another billing option, the option the Office Action particularly cites, is “allowing the call to continue outside their HNZ or subscribed-to VNZ’s and billing the customer for the air time.” The Office Action is suggesting that this option of “allowing” corresponds to the above-quoted disregarding step of claim 3 in the present application.

In response, however, the applicant first notes that the releasing and disregarding steps of claim 3 of the instant patent application relate to “call origination”

and “call termination.”

For example, the mobile switching center (MSC) may receive a call origination from the mobile terminal, i.e., the mobile terminal is placing a call. Likewise another party may place a call to the mobile terminal, causing the mobile terminal to receive a call termination. All of the terminology used in this example is well-known in the art.

Secondly, although the Office Action does not specify, presumably the thought is as follows. With respect to billing for a particular subscriber, if a processor in the MSC is set for the allowing option (col. 7, lines 24-25) rather than for the disconnecting option (col. 7, lines 21-24), the processor, by some stretch of the imagination, is “disregarding a call termination if the portable radio telephone deviated from the home zone receives the call termination.”

The applicant submits that a processor set for one option rather than another option cannot properly be characterized as “disregarding” the other option. Even if a human being caused the selection between the two options, the human being cannot properly be characterized as “disregarding” an option. In short, to select among options does not, in and of itself, involve “disregarding” an option.

Any fair reading of the releasing and disregarding steps recited in claim 3 of the instant patent application leads to the conclusion that the disregarding step does

not correspond to the Chow “allowing” billing option.

Tiedermann discloses a mobile station registration method, but fails to make up for the deficiencies in Bridges and Chow. Claim 3 is therefore believed to be patentable over the applied prior art for at least the above-stated reasons.

As to the other rejected claims, each depends from base claim 3 that has been shown to be patentable, and is likewise deemed to be patentable.

In view of the foregoing amendments and remarks, it is believed that this application is now in condition for allowance. The Examiner is invited to contact the undersigned in the event of any perceived outstanding issues so that passage of the case to issue can be effected without the need for a further Office Action.


Amendment  
Serial No. 09/632,995

Docket No. 5000-1-122

In the event that any additional fee is required to continue the prosecution of this Application as requested, please charge such fee to Deposit Account No. 502-470.

Respectfully submitted,

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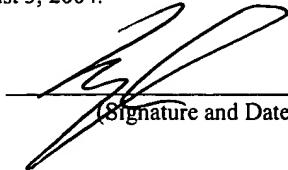
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